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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,230	03/11/2004	Melvin L. Hubbard	00118/005001	3466

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EXAMINER

TRUONG, THANH K

ART UNIT	PAPER NUMBER
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3721

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/19/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

NT

Office Action Summary

Application No.

10/798,230

Applicant(s)

HUBBARD, MELVIN L.

Examiner

Thanh K. Truong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,5-8,10-14 and 31-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,5-8,10-14 and 31-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to applicant's amendment received on October 3, 2006.
2. Applicant's cancellation of claims 1, 3, 4, 9 and 15-30 is acknowledged.

Terminal Disclaimer

3. The terminal disclaimer filed on October 3, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,609,576 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 6-8 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golobay (4,087,982) in view of Vural et al. (4,265,130).

Golobay discloses an apparatus and a method comprising:

providing a housing containing at least one off-center weight (42), the off-center weight coupled to a motor (52) and configured to rotate or revolve to vibrate the housing,

removably mounting the housing via a device mount to a mount on a vehicle (22) (figure 1);

providing a belt (54) to the first axle (44);

providing a belt coupled to the first axle;

providing a second axle (48) couple to the belt (belt (54) coupled between the first axle (44) and second axle (48) – Golobay, figure 4);

removably mounting a tool to a second axle (48), to perform a task (figure 4 shows the second axle (48) couple to the vibrator (28), and the tool is couple to the vibrator, thus it is construed that the tool is removably couple (or mounting) to the second axle); and

rotating or revolving the off-center weight (figure 2).

Golobay discloses the claimed invention, but does not expressly disclose the ratchet rotatably coupled to the housing, such that vibration of the housing causes rotation of the first axle.

Vural et al. discloses a ratchet (7) having a first axle (1) about which the ratchet may rotate, the ratchet rotatably coupled to the housing (the ratchet (7) rotated around the axle (1) which coupled to the housing, thus the ratchet is rotately coupled to the housing), such that vibration of the housing causes rotation of the first axle providing means to adjust the relative angular position and locking the adjustable weight in each setting by means of a set amount of friction (column 5, lines 5-10).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Golobay et al. by

incorporating the use of a ratchet as taught by Vural et al. providing means to lock and to adjust the relative angular position of the off-center weight.

Golobay further discloses: the tool is the cable layers; the cutting tool is a trencher; a cable-layering system, whereby cable may be laid while a trench is dug; and a soil separating system, whereby soil may be separated while a trench is dug.

6. **Examiner's note:** the Applicant had not previously properly challenged the Official Notice taken by the examiner (in the Office Action date **October 12, 2005** and in the Office Action date **June 26, 2006** to reject claims 5 and 10-14). In general, a challenge, to be proper, must contain adequate information or argument so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the Official Notice. Since the Applicant fails to properly challenge the Official Notice during examination, the Applicant's right to challenge the Official Notice is waived, and the subject matter recited in claims 5 and 10-14 is considered as Applicant's admitted prior art.

7. Claims 5 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golobay (4,087,982) in view of Vural et al. (4,265,130) and further in view of the Applicant's admitted prior art (see paragraph 6 above).

As discussed above in paragraph 7 of this office action, the combination of Golobay and Vural et al. disclose the claimed invention, but did not expressly disclose the tool is an asphalt cutter (claim 5), the tool is a drill (claim 10), etc.

The Applicant's admitted prior art established that it is old and well known in the art to attach varieties of tools (such as asphalt cutter, drill, etc. as recited in claims 5 and 10-14) to the housing of a vibration generator as one desires to achieve varieties of purposes.

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have attached varieties of tools to the housing of a vibration generator depending on the task required.

Response to Arguments

8. Applicant's arguments filed October 3, 2006 have been fully considered but they are not persuasive.

9. In response to the Applicant's argument that:

*"The Examiner has further rejected claims 2, 6-8, 31-33 as unpatentable over Golobay in view of Vural. **This rejection is essentially the same as that previously alleged in the prior Office Action**, but with the addition of claim 31 to the rejection. Applicant specifically pointed out in the prior Response significant and meaningful differences between the claimed invention and the prior art cited. The Examiner has stated that the arguments are moot in view of the "new ground of rejection". However, **the only new ground of rejection is the addition of claim 31**. The same rejections are provided for all the rest of the claims. If the grounds of rejection are maintained, the Examiner is requested to point out where the Applicant arguments are incorrect. These Applicant arguments are repeated below for the convenience of the Examiner." (emphasis added);*

this argument is not found persuasive because:

First of all, the office action dated June 26, 2006 **is not the same** as the office action dated October 12, 2005. If the Applicant has read the office action carefully, the Applicant would have seen the different grounds of rejection from the two office actions.

The differences may be subtle, but the ground of rejection between the two office actions is different from each other.

In the office action of June 26, 2006, there are these limitations (among others): belt (54), first axle (44), second axle (70), and claim 31 is not included in the rejection.

In the office action of October 12, 2006, there are these limitations (among others): belt (54), first axle (44), second axle (48), and claim 31 is included in the rejection.

And because of these new grounds of rejection, the office action dated October 12, 2006 was not a final rejection.

10. In response to the Applicant's argument that:

"First, Golobay fails to disclose a belt coupled between a first axle and a second axle. The belt cited by the Examiner, belt 54, is the belt which drives the eccentric weights, not the belt that runs between the axles to rotate a tool to do work. Golobay lacks such a belt because there is no second axle. As Golobay completely lacks this claim element, its combination with Vura/fails as a prima facie case of obviousness and Applicant submits the rejection should be withdrawn."

this argument is not found persuasive, because Golobay discloses (figure 4) first axle (44), second axle (48) and belt (54) coupled between the first and second axles as recited in the claim.

11. In response to Applicant's argument that there is no suggestion to combine the references:

"Even assuming, arguendo, that these deficiencies were met, Applicant respectfully submits that Vural is insufficient to provide that which the Examiner contends. In Vural, the gear ring or ratchet 7 cited by the Examiner is driven by the rotation of the first axle, as are the eccentric weights. The gear ring 7 of Vural is lockably adjusted by a hydraulic pawl 18. The ratchet is adjustable in this fashion so that the user can adjust the

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vibration amplitude. In the current system, the ratchet is not driven by the rotation of the axle that drives the eccentric weights. Rather, as claimed, the ratchet is mounted to the housing, and the vibration of the housing causes the rotation of the axle due to the ratcheting effect.”,

this argument is not found persuasive, because: the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 601 (CCPA 1915). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 110 USPQ 209 (CCVA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA. 1969).

In this case, Vural et al. discloses a ratchet (7) having a first axle (1) about which the ratchet may rotate, the ratchet rotatably coupled to the housing, such that vibration of the housing causes rotation of the first axle providing means to adjust the relative angular position and locking the adjustable weight in each setting by means of a set amount of friction (column 5, lines 5-10).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Golobay et al. by incorporating the use of a ratchet as taught by Vural et al. providing means to lock and to adjust the relative angular position of the off-center weight.

12. In response to the Applicant's argument that:

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"With regard to additionally-rejected claim 31, it is submitted that neither Golobay nor Vural disclose constricting the axle against rotation, thereby allowing the housing to rotate."

this is not found persuasive, because the modified Golobay et al. by Vural et al. clearly discloses the "constricting the axle against rotation" as recited in claim 31. The ratchet is, by its nature, "constricting" the axle against rotation (unidirectional).

Conclusion

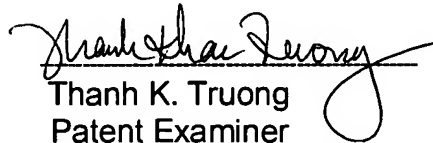
13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K. Truong whose telephone number is 571-272-4472. The examiner can normally be reached on Mon-Thru 8:00AM - 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Thanh K. Truong
Patent Examiner
December 14, 2006.